

Appl. No. 10/697,225
Docket No. 9396L
Amdt. dated November 7, 2007
Reply to Office Action mailed on August 7, 2007
Customer No. 27752

REMARKS

Claim Status

Claims 7 -12 are pending in the present application and stand rejected. Claims 7-12 are rejected under 35 U.S.C. § 103. Claims 7-12 are rejected under the judicially created doctrine of obviousness type double patenting. Claims 7 and 8 are provisionally rejected under the judicially created doctrine of obviousness type double patenting.

Rejection Under 35 USC §103 Over Igaue et al. in view of Inoue et al. as evidenced by Ehrnsperger et al.

Claim 7 has been rejected under 35 U.S.C. § 103 over Igaue et al. (GB 2,244,201) in view of Inoue et al. (US 6,320,096) as evidenced by Ehrnsperger et al. (US 2007/003272). This rejection is traversed.

The cited Ehrnsperger et al. document is not prior art. While in certain circumstances a document which is not prior art may be relied upon for evidentiary purposes in a § 103 rejection, none of those circumstances are applicable here. While the Office Action maintains that Ehrnsperger et al. is “not used to reject any claims” it is not clear for what purpose it is being used in the § 103 analysis. For reasons that are more fully discussed below, its use (whether for evidentiary purposes or to reject claims) in this case is inappropriate and the analysis contained in the Office Action pertaining to this document is improper use of a non-prior art document.

The Igaue et. document is characterized in the office action as teaching all elements of Claim 7 except for the visible highlighting. This reading of the Igaue et al. document is expressly not agreed with or acquiesced to. Nevertheless, even assuming the propriety of this reading of Igaue et al., both the proposed combination with Inoue et al. and the resulting article do not meet the requirements of a *prima facie* case of obviousness. The analysis in the Office Action suffers from errors of fact finding with respect to the Inoue et al. reference as applied to terms in Claim 7 and from errors in combining the teachings of Igaue et al. with Inoue et al.

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Pages 4-5 of the Office Action contain the analysis supporting the fact finding that Inoue et al. supposedly teaches a visibly highlighted wetness sensation member and the desirability of having such. While the Office Action does not use the term expressly, this analysis is based on an inherency analysis by comparing the structure of the second layer (22) (taken by the Office Action to be the same as the wetness sensation member) with the topsheet (2) and the first sheet (21) (taken by the Office Action to be the same as the flow control layer). The Office Action cites column 2, lines 30-67 through column 3, lines 1-10 of Inoue et al. as describing these differences.

The problem with the Office Action analysis, however, is that the cited portions (and the remainder) of the Inoue et al. documents pertain to the **fluid handling** characteristics **relative positioning** (such as a level difference) or other general physical characteristics (fiber density, basis weight and the like) of the portions of the article. From these descriptions, the Office Action jumps to an assumption that the second sheet (22) is visibly highlighted with respect to the remainder of the article within the meaning of Claim 7. This assumption is made without any reasonable evidence to support it.

There is no basis to conclude that **any** of the cited characteristics in Inoue et al. would result in a particular noticeable visible highlighting of the second sheet, much less would **necessarily and inevitably** produce such a result. In fact it is quite possible and common for nonwoven materials of the type described for the second sheet, the topsheet, and the first sheet of Inoue et al. to differ somewhat in fluid handling and physical characteristics described, yet all be generally white and appear about the same to the ordinary observer. The Office Action reasoning rests only on the speculation that since there is **some difference** (e.g. fluid handling desired characteristics) described between the parts of Inoue et al., there must be **this particular difference as well** (i.e. a visible highlighting of the second sheet). This finding finds no support in the evidence cited and is contrary to common examples in the disposable absorbent article field. A common facial tissue has different material and fluid handling properties than a diaper topsheet, but both are typically (though not necessarily white). There is no evidence (from Inoue et al. or otherwise of record) to suggest that if such a facial tissue were placed on a diaper topsheet it would be “visibly highlighted” within the meaning of Claim 7 as a consequence of the physical differences between the two materials.

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The very express definition from the instant specification of “visible highlighting” that the Office Action purports to be applying requires that the object so highlighted “noticeably stands out from its surroundings.” The Office Action points to a number of largely irrelevant teachings in the Inoue et al. document to assume the existence of this claim limitation. There simply is, however, no teaching in Inoue et al. that the second sheet is constructed so as to noticeably stand out from its surroundings and the teachings that certain features of the topsheet can differ from certain features of other layers does not serve as the basis to make reasonably such a conclusion. Without this fact finding, the *prima facie* case with respect to Claim 7 must fail because all limitations of Claim 7 have not been shown to be present in the references even if properly combined in the first instance.

The rejection of Claim 7 as described above is also improper because it rests upon an improper combination of Iguae et al. and Inoue et al. in the first instance. The only analysis in the Office Action pertaining to the propriety of the combination is contained on Page 5. After assuming that Inoue et al. discloses the claimed visibly highlighted wetness sensation member, it concludes that the teachings are combinable as an “obvious matter of design choice” because it is “within the general skill of a worker in the art to select a known material on the basis of its suitability” taken to be appearance in this case. This analysis simply assumes and concludes that which is necessary to shown in the first instance.

As noted above, there is no teaching in Inoue et al. that the second sheet (22) is visibly highlighted with respect to the remainder of the article. There is no suggestion of the desirability of such highlighting, a reason to include it, or even a recognition of the problem or the benefits provided. While it may be the case that it was “within the level of skill in the art” to provide such a feature, the analysis of the Office Action puts forth no reason to show that it would be obvious to do so based upon any of the recognized rationales for establishing a *prima facie* case of obviousness.

The Office Action goes on to cite the Ehrnsperger et al. document for “evidentiary” purposes. This document is, of course, not prior art. The Office Action cites it on Page 5 to show that a wetness sensation member or acquisition layer may be highlighted for visibility “if desired.” All this does is demonstrate that at some time after the applicants invention was made, the art (later) realized that making the applicants’

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invention was possible. This is completely besides the point of a showing of obviousness which must come from the **prior art**, not later documents. A later document can be used for some purposes such as to show generally the level of ordinary skill, or to show the factual inherency of some feature disclosed in the art, or to show operability of the prior art. None of those limited exceptions cited in MPEP 2124 are applicable here. Without such an exception, reliance (for “evidence” or otherwise) on the Ehrnsperger et al. document runs afoul of the first Graham inquiry to determine the scope and contents of the **prior art**.

The Office Action in its last paragraph pertaining to this rejection appears to dismiss the “criticality” of the visible highlighting feature of Claim 7. It is unclear what this means, but the reasoning appears to be improper. All claim elements are material and must be considered for patentability. The visible highlighting of the wetness sensation member is an express feature of Claim 7. While the claimed visible highlighting can take several forms (different colors, hues, tints, etc. can be used to achieve it) it does not follow that the claim feature is, therefore, not “critical.” The Office Action concludes that the highlighting is purely a matter of “design choice.” This is simply not the case. The **existence** of the visible highlighting is an express claim feature. Certain **details** (for example its color) are unspecified and, therefore, may vary. It is, however, completely improper for the Office Action to take examples of permissible choices in the disclosure and use them against the applicant to argue that the feature itself is merely a “design choice” and, therefore, obvious.

Because the rejection of Claim 7 under 35 U.S.C. § 103 is improper for all of the reasons discussed above, this rejection should be withdrawn and the claim should be allowed.

Rejections Under 35 USC §103 Over Igaue et al. in view of Inoue et al. in further view of Roe et al.

Claims 8-12 have been rejected under 35 U.S.C. § 103 over Igaue et al. in view of Inoue et al. and further in view of Roe et al. (US 6,627,786). These rejections are traversed. Claims 8-12 all depend from Claim 7. The rejections of these claims in the

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Office Action all proceed from the base rejection of Claim 7 as discussed above. The addition of the Roe et al. patent, even if proper in the first instance does nothing to cure the deficiencies noted above with respect to the rejection of Claim 7. Roe et al. is added for teachings about the structural aspects of the wetness sensation member including, for example, spacing sizing, and Z-folding. None of this teaching, however, addresses the failure of the applied references to teach, alone or in combination, the claimed combination of a wetness sensation member having the visible highlighting claimed and described above. As such, a proper *prima facie* case of obviousness with respect to Claims 8-12 has not been established and these rejections should be withdrawn.

Double Patenting Rejection

Claims 7-12 are rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 4 and 7-11 of U.S. Patent 6,627,786. This patent is the Roe et al. patent discussed above. The cited Claims of Roe et al. are directed to absorbent article having a wetness sensation member. The claims make no mention of a visibly highlighted wetness sensation member. In fact, if they did, this fact should have been used above. In contrast, Roe et al. was used as the third reference in a 3-reference combination to reject Claims 7-12. Now, somehow, just the Claims of Roe et. al taken alone define an obvious variant of Claims 7-12. The entirety of the analysis on this point comes in one sentence that “it is known in the diaper art to highlight features of a diaper for visibility if desired.” In fact, no showing has been made in the Office Action whatsoever. Only a document which is **not prior art** was cited for such a proposition. Roe et al. itself is not cited for this teaching nor is any other prior art reference. Therefore, the initiation showing of obviousness between the invention defined by Claims 1, 4, and 7-11 of Roe et al. and Claims 7-12 of the instant application has not been made. This rejection should, therefore, be withdrawn and the claims should be allowed.

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Provisional Double Patenting Rejection

Claim 7 is provisionally rejected under the judicially created doctrine of obviousness type double patenting over Claims 1 and 6-8 of Application No. 10/815,918. As previously noted in a prior reply, this Application No. 10/815,918 has been expressly abandoned, making this rejection moot.

Claims 7 and 8 have been provisionally rejected for double patenting over Claims 1 and 3-5 of Application No. 10/281,791. It is expressly not admitted that these double patenting rejections are proper. Nevertheless, Applicants decline to address the ODP rejections on the merits unless and until potentially conflicting claims are in fact patented.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC § 103 and obviousness type double patenting. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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